UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,353	03/26/2001	Philip S. Siegel	067439-0111	4525

5073   7590   09/03/2009
BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201-2980

EXAMINER
SHAAWAT, MUSSA A

ART UNIT	PAPER NUMBER
3627	

NOTIFICATION DATE	DELIVERY MODE
09/03/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptomail1@bakerbotts.com
glenda.orrantia@bakerbotts.com

PTOL-90A (Rev. 04/07)

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/817,353
Filing Date: March 26, 2001
Appellant(s): SIEGEL, PHILIP S.

Newgistics, Inc

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 05/20/2009 appealing from the Office action

mailed 11/19/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

A copy of each Appeal Brief filed on April 15, 2009 relating to United States Patent Application Serial No. (10/750,935) and (10/751216) are included in Appendix C, attached in Appellants appeal brief.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,980,962	Arganbright	12-2005
2002/0010634	Roman	01-2002
6,246,997	Cybul	01-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1-2, 4-6, 9, 35-41 and 44-46 rejected under 35 U.S.C. 103(a) as being unpatentable over Arganbright et al, US Patent No. (6,980,962) referred to hereinafter as Arganbright in view of Cybul et al., US Patent No. (6,246,997) referred to hereinafter as Cybul.

As per claim 1, Arganbright teaches a method for processing the returns of merchandise purchased through the World Wide Web comprising: receiving from a consumer an electronic request via a computerized system associated with the consumer, the electronic request requesting to initiate processing of one or more items of merchandise purchased by the consumer in a prior purchase transaction (see at least col.62 line 65-col.63 line 10); and in response to receiving the electronic selection of

particular item or merchandise, initiating a returns process for the particular item of merchandise chosen by the consumer, the return process initiated by return server (see at least col.63 lines 8-11).

Arganbright does not expressly teach in response to receiving the electronic request from the computing system associated with the consumer gathering transaction history data associated with the consumer from a computerized database; displaying the transaction history associated with the identified consumer to the consumer on the computerized system associated with the consumer, the transaction history identifying a listing of merchandise associated with the consumer; in response to and after displaying the transaction history, receiving an electronic selection, generated by the consumer on the computerized system associated with the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and identifying the particular item of merchandise.

However Cybul teaches accessing or gathering previous shopping history or transaction history data associated with a consumer from a computerized database (see at least Abstract, and col.4 lines 40-50); displaying the previous transaction or shopping history via a web browser interface where the previous shopping history is associated with the consumer (see at least col.3 line 65-col.4 lines 15); in response to displaying the transaction history associated with the consumer, receiving an electronic selection of a particular of at least an item by the consumer using the browser interface, the electronic selection comprising a click on the particular item of merchandise and

identifying the particular item of merchandise (see at least col.4 lines 25-35, consumer selecting previous shopping history). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Cybul into the disclosure of Arganbright in order to provide the consumer with the option to return items via internet or online.

As per claim 2, Arganbright teaches a method of Claim 1 further comprising retrieving a preference profile for the identified consumer (see col. 62 lines 43-45)

As per claim 4, Arganbright teaches a method of Claim 1 further comprising notifying a retailer associated with the item selected by the consumer (see col.63 lines 8-11

As per claim 5, Arganbright teaches a method of Claim 4 further comprising providing the retailer with the transaction information and consumer information associated with the item selected by the consumer (see col. 63 lines 8-11

As per claim 6, Arganbright teaches a method of Claim 1 further comprising generating a return shipping label for the merchandise to be returned (col. 63 lines 23-30)

As per claim 9, Arganbright teaches a method of Claim 1 further comprising communicating between a client system and a server system via the Internet (see col. 63 lines 1-11).

As per claim 37, Arganbright teaches a method of Claim 1, wherein identifying the consumer comprises identifying the consumer using a login process (see col. 48 lines 50-65).

As per claim 38, Arganbright teaches a method of Claim 37, further comprising requesting transaction history data from a retailer on a real-time basis upon identifying the consumer using the login process (see at least col. 62 lines 42-45).

As per claim 39, Arganbright teaches a method of Claim 1, further comprising receiving transaction history data from a retailer on a periodic basis (see at least col. 48 lines 1-65).

As per claim 35, Arganbright teaches a method of Claim 2, further comprising completing the returns process based upon settings in the consumer preference profile (see col. 62 lines 42-45, and col. 63 lines 1-20).

As per claim 36, Arganbright teaches a method of Claim 2, wherein the consumer preference profile comprises a name associated with the consumer, credit information associated with the consumer, and shipping information associated with the consumer (col. 62 lines 42-45, and col. 63 lines 1-20, and col. 71 lines 9-10).

As per claim 40, Arganbright teaches a method of Claim 1, wherein the listing of merchandise in the transaction history is indicative of merchandise purchased by the consumer from an e-tailer (see at least col. 48 lines 1-65, col.62 lines 30-50).

As per claim 41, Arganbright teaches a method of Claim 1, wherein identifying the consumer comprises receiving a client system identifier in a message from the consumer (see col. 48 lines 1-65).

As per claim 44, Arganbright teaches a method of Claim 1, wherein initiating the return process comprises determining if the selected item of merchandise is perishable (see col. 63 lines 10-20).

As per claim 45, Arganbright teaches a method of Claim 1, wherein initiating the return process comprises using the computerized system associated with the consumer to generate a return shipping label to be used to return the selected item (see col. 63 lines 10-35).

As per Claims 41 and 46, the limitations of claims 41 and 46 are similar to the limitations of claim 1; therefore it is rejected based on the same rationale

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 3, 7-8 and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arganbright in view of Cybul in further view of Roman et al., US PG Pub. No. (US 2002/0010634 a1).

As per claim 8, Arganbright in view of teaches all the limitations of claim 8, except for auctioning the merchandise selected for return by the consumer. However, Roman teaches returns disposition including resale of product returns via auction over the internet (see at least Para [0003]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Roman into the disclosure of Arganbright in view of Cybul in order to minimize the loss of revenues of the merchant.

As per claim 3, Arganbright in view of Cybul does not expressly teach crediting a consumer account indicated in the consumer preference profile based upon the item selected. However Roman teaches crediting a consumer's account (see at least Para [0017]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Roman into the disclosure of Arganbright in view of Cybul, for the convenience of the consumer and consumer satisfaction.

As per claim 7, Although Arganbright in view of Cybul teaches printing a shipping label in conjunction with United States Postal Service for Example, Arganbright does not expressly teach notifying a shipping provider of a merchandise return to be picked up. However Roman teaches notifying a shipping provider to pick up the merchandise (see at least Para [0020]). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Roman into the disclosure of Arganbright in view of Cybul in order to provide the customer with an added convenience.

RE: Claim 42, Arganbright in view of Cybul does not expressly teach the step of determining whether the return is valid prior to the downloading step. However Roman teaches the step of determining whether the return is valid prior to the downloading step (see pp 0016 line 2 submitted return is analyzed for fraud against a database). It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Roman into the disclosure of Arganbright in view of Cybul in order to prevent the invalid return of merchandise.

RE: Claim 43: Arganbright in view of Cybul does not expressly teach comparing information associated with the selection of the item of merchandise to at least one return rule of a retailer associated with the transaction. However Roman teaches an e-tailer establishes parameter e.g. rules to determining whether the return is valid, see pp 0016 Roman et al. It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Roman into the disclosure of Arganbright in view of Cybul the motivation being the same as in claim 10.

(10) Response to Argument

The examiner summarizes the various points raised by the appellant and addresses them individually.

As per appellant's arguments filed on 05/20/2009, the appellant argues:

Argument A) the proposed combination of Arganbright and Cybul do not teach "receiving an electronic selection, generated by the consumer on the computerized system associated with the consumer, of a particular item of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise for returns processing", **(see AB top of page 5)**.

In response to Argument A) the examiner respectfully disagrees. Cybul teaches receiving an electronic selection, generated by the consumer on the computerized system associated with the consumer, of a particular item of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise for returns processing (see at least col.4 lines 25-35,

consumer selecting previous shopping history). Therefore Arganbright in view of Cybul still meets the scope of the limitation as currently claimed.

Argument B) the proposed combination of Arganbright and Cybul do not teach "in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server" (**see AB top of Page 8**).

In response to Argument B) the examiner respectfully disagrees. Arganbright teaches receiving a selection of an item from the consumer the selection comprising either return or exchange of an item via a user interface and an electronic request to initiate return processing (see at least col. 63 lines 1-35). In addition, Cybul teaches an electronic selection comprising a click on a particular item of merchandise from a list of merchandise. Therefore Arganbright in view of Roman still meets the scope of the limitation as currently claimed.

Argument C) the proposed combination of Arganbright and Cybul do not teach "gathering transaction history data associated with the customer from a computerized database" (**see AB top of Page 10**).

In response to Argument C) the examiner respectfully disagrees. Cybul teaches accessing or gathering previous shopping history or transaction history data associated with a consumer from a computerized database (see at least Abstract, and

col.4 lines 40-50). Therefore Arganbright in view of Cybul still meets the scope of the

limitation as currently claimed.

Argument D) the proposed combination of Arganbright and Cybul do not teach

"receiving transaction history data from a retailer on a periodic basis" **(see AB bottom**

of Page 12).

In response to Argument D) the examiner respectfully disagrees. Cybul

teaches receiving transaction history data from a retailer on a periodic basis (see at

least Abstract, and col.48 lines 1-65). Therefore Arganbright in view of Cybul still meets

the scope of the limitation as currently claimed.

Argument E) the proposed combination of Arganbright-Roman and Cybul do not

teach "wherein initiating the return process comprises determining if the selected item of

merchandise is perishable" **(see AB Middle of Page 13)**.

In response to Argument E) the examiner respectfully disagrees. Arganbright

teaches wherein a user is requested to enter a plurality of information regarding the item

to be returned some of which is the reason for return product description which includes

if the item is perishable or expired (see at least col. 63 lines 23-35). Therefore

Arganbright in view of Cybul still meets the scope of the limitation as currently claimed.

Argument F) the Appellant argues that there is no motivation to combine references of Arganbright in view of Cybul in view of Roman **(see AB bottom page 20-22)**.

In response to argument F) examiner respectfully disagrees. The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Additionally, it is noted that KSR forecloses the argument that a **specific** teaching, suggestion, or motivation is required to support a finding of obviousness. Under KSR, a claim would have been obvious if the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention. Furthermore, under KSR, a claim would have been obvious if a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art. One of ordinary skill in the art would have been capable of applying the teachings of Roman and Cybul into the disclosure of Arganbright and the results would have been predictable to one of ordinary skill in the art.

Argument G) the proposed combination of Arganbright and Cybul do not teach "completing the returns process based upon settings in the consumer preference profile" **(see AB top of Page 11)**.

In response to Argument G) the examiner respectfully disagrees.   Cybul

teaches completing the returns process based upon settings in the consumer

preference profile (see col. 62 lines 42-45, and col. 63 lines 1-20.   Therefore

Arganbright in view of Cybul still meets the scope of the limitation as currently claimed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/MUSSA SHAAWAT/
Examiner, Art Unit
August 18, 2009

Conferees:

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627

Vincent Millin/vm/
Appeals Conference Specialist